United States Code, Title 17:

§10. *Publication of work with notice*

Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor, except in the case of books seeking ad interim protection under section 22 of this title.

United States Code, Title 17:

§19. *Notice; form*

The notice of copyright required by section 10 of this title shall consist either of the word "Copyright", the abbreviation "Copr.", or the symbol "©", accompanied by the name of the copyright proprietor, and if the work be a printed literary, musical, or dramatic work, the notice shall include also the year in which the copyright was secured by publication. In the case, however, of copies of works specified in subsections (f) to (k), inclusive, of sections 5 of this title, the notice may consist of the letter C enclosed within a circle, thus ©, accompanied by the initials, monogram, mark, or symbol of the copyright proprietor: *Provided*, That on some accessible portion of such copies or of the margin, back, permanent base, or pedestal, or of the substance on which such copies shall be mounted, his name shall appear. But in the case of works in which copyright was subsisting on July 1, 1909, the notice of copyright may be either in one of the forms prescribed herein or may consist of the following words: "Entered according to Act of Con-

gress, in the year , by A.B., in the office of the Librarian of Congress, at Washington, D.C.," or, at his option, the word "Copyright", together with the year the copyright was entered and the name of the party by whom it was taken out; thus, "Copyright, 19 , by A.B."

United States Code, Title 17:

§26. *Terms defined*

In the interpretation and construction of this title "the date of publication" shall in the case of a work of which copies are reproduced for sale or distribution be held to be the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority, and the word "author" shall include an employer in the case of works made for hire.

Statement of the Case

The petitioners are two ex-servicemen. Goodman served in the Army from April 1957 to April 1959; Scherr from October 1957 to October 1959. Both men, prior to induction, had had education and experience in the fine arts. They were assigned as illustrators to Headquarters Company at Fort Dix, New Jersey, where their duties included the preparation of visual training aids. During his free time, Goodman, using supplies given him by the post hobby shop, began to make a small model of an infantryman which was brought to the attention of General Heintges, deputy post commander. The latter expressed interest in having constructed a larger statue of an infantryman which would serve as a symbol of Fort Dix. After some preliminary research as to the feasibility of

such a project it was agreed that Goodman and Scherr would undertake it. Both men were thereupon relieved of their regular duties as illustrators and they set about to create the proposed statue.

Upon completion of the statue there was a formal dedication and the statue now stands on permanent display in Infantry Park, Fort Dix, New Jersey.

The petitioners obtained registration of their claim for copyright of said statue, No. GP 21088.

This action instituted in the United States District Court for the Southern District of New York, arises from respondent Universal's production and distribution, with the authorization of the Army, of books of matches bearing on the cover a picture of the statue and the legend: "Home of The Ultimate Weapon Fort Dix N. J." The United States (the Government), not originally named as a defendant, intervened.

The respondents in this copyright infringement action moved for summary judgment dismissing the complaint on the ground that the subject matter, a statue made at Government expense, created by soldiers while on active military duty, belonged to the Government, was a publication of the United States Government and thus not copyrightable; and that in any event the claimed copyright is invalid for failure of the petitioners to affix an adequate notice of copyright to the statue.

Summary judgment in favor of the respondents was granted to the extent and for the reasons stated in the District Court opinion. This judgment was affirmed by the Circuit Court, on the ground that petitioners came under the "works for hire" rule and that petitioners had no copyrightable interest in the creation, namely the statue. Judge Friendly wrote a dissenting opinion.

Reasons for Granting the Writ

1. Constitutional Rights Are Involved.

This Court has never been more acutely concerned with the constitutional rights of its individual citizens. The male citizen eligible for the draft is fearful of the loss of his constitutional rights. We are all exposed, through news media, with the individual's efforts to establish through the courts some formulation of the doctrine that civilian constitutional rights follow a man into the military service.

One reason for this Court to grant the writ herein could not be advanced better than as stated by Judge Friendly in his dissenting opinion:

> ". . . While facts like these may be unlikely to recur, the implications of the opinion are sufficiently alarming to call for an expression of dissent."

The petitioners cannot be deprived of their constitutional grant to secure exclusive right to their creation (Article I, Section 8, (clause 8)), by §26, Title 17, U. S. C., which does not apply because of the special circumstances of this case.

As stated by Judge Friendly, referring to §26, Title 17, U. S. C.:

> ". . . It would thus be quite doubtful that Congress could grant employers the exclusive right to the writings of employees regardless of the circumstances. . . ."

2. Is Soldiering an "Employment" by the United States Army.

The Circuit Court, in affirming the judgment of the District Court, made such decision upon the sole basis that

if any copyright exists, it is the exclusive property of the United States Government, and accordingly did not have to decide whether the District Court was correct in ruling that the statue was not a "Government publication" or that the notice of copyright was inadequate. The Circuit Court decided the appeal solely upon the "works for hire" rule as defined in 17 U. S. C. §26.

The respondents advanced many cases in support of their position that the "works for hire" rule should apply to the instant case. However, in all of the cases cited the employment was voluntarily entered into and the author, composer or inventor was creating something in connection with his duties under his employment. The employees therein could have left their employment at any time and sought other employment. They were employed to perform the task for which they were hired, which would eventually result in a commercially exploitable product.

The United States Army is not in the business of making money. Except for civilian employees who are engaged pursuant to 10 U. S. C. §§4022, 4024 and 4025, all of the members of the Army are subject to the rules and regulations of the Army.

The precatory suggestion of General Heintges was tantamount to an order. A serviceman whose advancement and leave are in the discretion of his superiors, does not take lightly the precatory wish of a General.

The petitioners were not "hired" by the Army to create and make a statue which serves no military purpose. They were assigned to illustrate manuals for training purposes. It was General Heintges' wish which diverted them from necessary training programs to a non-military program of statue creating and building.

Those who serve in the Army voluntarily or by proscription, as do jurymen in serving their government, often do so at a substantial financial loss. But when a member of the Army has special artistic attributes which he can exploit while still in service, there should be no reason why he cannot enjoy the same rights and privileges of a civilian, and reap the benefits of his artistic skills.

The famous bandmaster, John Philip Sousa composed and copyrighted hundreds of musical compositions while he was in the military service, and for years reaped the benefits of his talents as a composer. (See *Public Affairs Associates, Inc.* v. *Rickover,* 284 F. 2d 262.)

Judge Waterman in the Circuit Court's opinion, asserted:

> ". . . On the other hand, plaintiffs here did possess some bargaining power. They were not required to engage in the work they did in order to fulfill their military obligations; they did so voluntarily. . . ."

This is a conclusion that is not warranted by the facts. A soldier has very little bargaining power, if any, when a General tells him that he would like something to be done. Should this slight "bargaining power" be developed into an employment relationship?

To give to the United States of America the ownership of the copyright of the petitioners' talents tortures the meaning of Article I, Section 8 of the Constitution and of the definition contained in 17 U. S. C. §26.

As Judge Friendly significantly notes, in his dissenting opinion even the majority opinion concedes ". . . it is somewhat of a strain to classify such a relationship as one of employment voluntarily entered into . . .", referring to petitioners' status as soldiers.

3. This Court Should Interpret the Provisions of §§8, 10, and 19 of Title 17, U. S. C., As They Relate to the Particular Circumstances of This Case.

The District Court held that the statue was not a "Government publication" and that the notice was inadequate.

The Circuit Court, in affirming, did not find it necessary to decide whether the statue in question was a "Government publication" or whether the notice of copyright was adequate.

The dissenting opinion of Judge Friendly disagreed with the District Court on the question of adequacy of the copyright notice and held it to be adequate.

Such a deep division over the interpretation of the Copyright Law (Title 17, U. S. C.) after it has been in effect since 1909 (over 60 years), demands the attention of and definitive resolution *by this Court.*

CONCLUSION

For these reasons, a writ of certiorari should issue to review the judgment and opinion of the Second Circuit.

Respectfully submitted,

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Counsel for Petitioners.

January 8th, 1970.

APPENDIX

Judgment of United States Court of Appeals for the Second Circuit

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the fifteenth day of October one thousand nine hundred and sixty-nine.

Present:

HON. STERRY R. WATERMAN,
HON. LEONARD P. MOORE,
HON. HENRY J. FRIENDLY,
Circuit Judges.

STUART SCHERR and STEVEN GOODMAN,
Plaintiffs-Appellants,

v.

UNIVERAL MATCH CORPORATION and
UNITED STATES OF AMERICA,
Defendants-Appellees.

Appeal from the United States District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the Southern District of New York, and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ordered, adjudged, and decreed that the judgment of said District Court be and it hereby is affirmed.

A. DANIEL FUSARO
Clerk

Opinion of United States Court of Appeals for the Second Circuit

WATERMAN, *Circuit Judge*:

This is an action for copyright infringement brought by two ex-servicemen against Universal Match Corporation occasioned by Universal's commercial manufacture and sale of match books which bear a picture of a statue, entitled "The Ultimate Weapon." The statue had been created by plaintiffs during their service in the military. The complaint seeks an injunction against further infringement and an accounting of the profits, or, in lieu thereof, damages of $10.00 for each infringing match book copy. The United States of America, which had consented to Universal's commercial exploitation of "The Ultimate Weapon" without payment to plaintiffs, intervened as a defendant and interposed an answer denying plaintiffs' copyright and, alternatively, counterclaimed for an assignment of the copyright if it should appear that plaintiffs may have acquired one.

Both defendants moved for summary judgment. The district court held that there were no genuine issues of material fact and we agree with that holding. The opinion is reported at 297 F. Supp. 107 (SDNY 1967) (McGohey, *J.*). All the facts are undisputed except that appellants charge that the Army orally agreed to share with them any revenue derived from the commercial reproduction of the statue by others. This allegation is entirely lacking in supporting proof and hence the court below correctly disposed of the parties' claims in this litigation on defendants' motion for summary judgment.

Plaintiffs served in the United States Army during the years 1957 through 1959. As they had had some education and experience in the fine arts, both were classified as

illustrators and were assigned to the preparation of visual training aids at Fort Dix, New Jersey. During their leisure hours the two men put their artistic talents to further use. Plaintiff Goodman, with some assistance from plaintiff Scherr, was making a small clay table model of an infantryman when their creativity caught the eye of a public relations officer who brought them and their work to the attention of the deputy post commander. He, too, was favorably impressed, and suggested the construction of a larger, life-size statute of an infantryman which would serve as a symbol of Fort Dix. Goodman and Scherr agreed to undertake the project.

Thereafter, for approximately nine months, plaintiffs were relieved of their regular duties as illustrators and they devoted substantially all of their duty hours and some of their leisure time to "The Ultimate Weapon," the name the Army decided the statue should receive. During all stages of design and construction of the statue, the cost of the project was borne almost exclusively by the Army.[1] It supplied the necessary physical facilities, equipment, materials, and additional skilled and unskilled labor force. Total government expenditures were estimated at $12,367.90. Additionally, plaintiffs were at all times accountable to their military superiors to whom they submitted written progress reports.

On March 17, 1959 the statue was completed, and it was dedicated on March 20, 1959. Since its unveiling, it has at all times been, and is today, on public view at Infantry Park, Fort Dix, New Jersey. While the idea for the

[1] Plaintiffs' only expenses were estimated at less than $25.00 each for tools and books. Further, it has never been claimed that reimbursement, if requested, could not have been obtained.

statue originated from the smaller clay model, the statue differs from the model. Moreover, plaintiffs never attempted to secure a copyright for their original clay model. Their claim of infringement rests solely upon whether they possess an effective copyright in the finished statue.

The statue is some 25 feet high. It consists of a 12 foot figure of a charging infantryman in full battle dress, with rifle thrust forward, with a field pack on his back, and with a bayonet, sheath, a shovel, canteen, hand grenades, and other implements attached to a cartridge belt supported by suspenders. He stands upon a pile of rocks about 3 feet high which, in turn, is set upon a 12 foot base. On the base are two plaques. The larger of them is inscribed: "The Ultimate Weapon, the only indispensable instrument of war, the fighting man." The smaller plaque bears the names of plaintiffs and two of their assistants. Neither plaque bears any copyright notice.

However, the plaintiffs affixed a notice of copyright to the statue prior to the unveiling.[2] Fearing they would encounter difficulties if the Army became aware of their copyright claim, they purposely placed the notice where it would not be readily detectable. They put it on the pack resting on the soldier's back where it is twenty two or twenty three feet above the ground and is entirely invisible to anyone standing on the ground. Subsequently, some three months after the unveiling, plaintiffs registered their claim of copyright in "The Ultimate Weapon."

Defendants' motion for summary judgment raised three defenses to plaintiffs' copyright claim. First, they asserted

[2] The notice affixed by plaintiffs contains a letter C enclosed within a circle; the names Stuart Scherr and Steven Goodman; and the date, 1959.

that "The Ultimate Weapon" was a "publication of the United States Government" within the meaning of 17 U.S.C. §8, and therefore not copyrightable. It was also urged that the notice of copyright was inadequate, see 17 U.S.C. §§10, 19; 37 C.F.R. §202(a)(2), and it was further claimed that any and all copyright interest belongs to the U. S. Government because the statue was constructed during the course of plaintiffs' employment by the U. S. Army. 17 U.S.C. §26. The district court held the statue was not a "publication of the United States Government" but granted defendants' motion based upon the assertions that the copyright notice was inaccessible to view and hence inadequate, and that if there were a valid copyright it inures to the benefit of plaintiffs' employer, the United States Army.

We agree that if any copyright interest exists, it is the exclusive property of the United States Government, and on this basis we affirm the judgment below. Accordingly, we do not have to decide whether the district court was correct in ruling that the statue was not a "Government publication" and that the notice of copyright was inadequate.[3]

"Authors and proprietors" according to §9 of the Copyright Law, 17 U.S.C. §9, are entitled to the copyright of a work of art. By §26, 17 U.S.C. §26, an "author" is fur-

[3] The district court thought its alternative holding that the copyright notice was invalid obviated the need for it to decide whether the Government is entitled on its counterclaim to an assignment of the copyright or whether the Government's remedy is limited to having a judicial declaration that the copyright is valid and should be held in trust for it. Though we have not considered the question of the validity of the notice, we do not see any necessity to make such determinations.

ther defined to include "an employer in the case of works made for hire." This is not to say, however, as the literal language of the statute might imply, that an employer and an employee are precluded as a matter of law from agreeing that the copyright in the resulting work shall vest in the employee. See, generally, Nimmer, Copyright §62.1 (1968). Rather, §26 merely creates a rebuttable presumption of copyright in the employer, a presumption which can be overcome by evidence of a contrary agreement between the parties. Id., *Brattleboro Publishing Co.* v. *Winmill Publishing Corp.*, 369 F. 2d 565, 567-568 (2 Cir. 1966) (Kaufman, *J.*); *Yardley* v. *Houghton Mifflin Co.*, 108 F. 2d 28 (2 Cir. 1939), *cert. denied*, 309 U.S. 686 (1940) (presumption rests upon presumed intention of parties); *Kinelow Publishing Co.* v. *Photography in Business, Inc.*, 270 F. Supp. 851 (SDNY 1967). But see in *Brattleboro, supra* at 569 (concurring opinion, Lumbard, *Ch. J.*) (no rebuttable presumption to be overcome—intention of parties controlling).

In the case at bar, the bare allegations by plaintiffs of an agreement contrary to the statutory presumption, without more, do not negate the presumption and do not create a triable issue of fact as to the intention of the parties. See *supra* at pp. 3652-3653.

Even if it be assumed that the relationship here was an employment relationship, it is only when "an employee creates something in connection with his duties under his employment, [that] the thing created is the property of the employer and any copyright obtained thereon by the employee is deemed held in trust for the employer," *Sawyer* v. *Crowell Pub. Co.*, 46 F. Supp. 471, 473 (SDNY 1942), *aff'd*, 142 F. 2d 497 (2 Cir.), *cert. denied*, 323 U.S.

735 (1944). Also see *Brown* v. *Molle Co.*, 20 F. Supp. 135, 136 (SDNY 1937), citing *Bleistein* v. *Donaldson Lithographing Co.*, 188 U.S. 239 (1903). We must consider whether this doctrine applies to this case.

The essential factor in determining whether an employee created his work of art within the scope of his employment as part of his employment duties is whether the employer possessed the right to direct and to supervise the manner in which the work was being performed. Nimmer, Copyright §62.2 (1968); *Donaldson Publishing Co.* v. *Bregman, Vocco & Conn, Inc.*, 375 F. 2d 639 (2 Cir. 1967). Other pertinent, but non-essential, considerations are those indicating at whose insistence, expense, time and facilities the work was created. See *Sawyer* v. *Crowell Pub. Co.*, *supra* at 473, but see *Public Affairs Associates, Inc.* v. *Rickover*, 284 F. 2d 262 (D. C. Cir. 1960), *vacated per curiam on other grounds*, 369 U.S. 111 (1962), on remand, 268 F. Supp. 444 (D. D. C. 1967) (held use of government duplicating machine, government paper and government secretary not determinative). Additionally, the nature and amount of compensation or the absence of any payment received by the employee for his work may be considered; but when compared with the above factors it is of minor relevance. See Nimmer, *supra* at §62.2.

Under the foregoing test it is strikingly obvious that if an employer-employee relationship between the Government and these plaintiffs actually existed, any ownership in the work designed by plaintiffs necessarily belongs to the Government. The Army's power to supervise; its exercise, though a limited one, of that power; and the overwhelming appropriation of government funds, time and facilities to the project, are all undisputed. These

facts contrast sharply with the facts in the cases plaintiffs rely upon to support a contrary conclusion. *Public Affairs Co.* v. *Rickhover, supra; United States* v. *First Trust Co. of Saint Paul*, 251 F. 2d 686 (8 Cir. 1958); *Sherrill* v. *Greaves*, 57 Wash. L. Rep. 86 (D.C. Super. Ct. 1929). Each of those cases concerns writings of government employees relating to their employment, but written for the most part *during off-duty hours;* whereas plaintiffs created their work of art pursuant to a formal government-commissioned project undertaken at almost complete government expense *during regular duty hours.*

Plaintiffs, however, contend that since they were classified in a military occupation specialty [(MOS) 814.10] as illustrators and were not reclassified as sculptors, their work as sculptors was outside the regular course of their employment. Their position is untenable. The failure of a serviceman's MOS classification to depict accurately his work assignment is, at most, a technical error, and cannot under any circumstances suffice to determine copyright ownership.

Arguably, however, Congress only intended the "works made for hire" statute to extend to voluntarily formulated employment relationships, and appellants therefore would maintain that the relationship between the United States Government and its military personnel who are drafted or who enlist to avoid induction goes beyond the act's contemplation. Certainly it is somewhat of a strain to classify such a relationship as one of employment voluntarily entered into. Unlike the ordinary employment contract that a talented person might be successful in obtaining from an employer, even the most talented serviceman does not possess the bargaining power to

negotiate with the military the terms of his service. On the other hand, plaintiffs here did possess some bargaining power. They were not required to engage in the work they did in order to fulfill their military obligations; they did so voluntarily. In all probability they were glad to be relieved of their regular duties and welcomed the opportunity to be engaged in work more akin to their artistic talents. Perhaps, had they openly expressed their desire to retain a copyright interest in their artistic creation, the Army would not have objected. On balance, therefore, in light of the voluntary nature of plaintiffs' work; the compensation received, though assuredly minimal; and the absence of any concrete evidence of legislative intent to exclude from the coverage of 17 U.S.C. §26 any works created by military personnel while fulfilling their obligation to serve their country, we must conclude that the Government did not violate any right of the plaintiffs when it agreed that defendant Universal could depict "The Ultimate Weapon" upon its match book covers.

The judgment below is affirmed.

FRIENDLY, *Circuit Judge* (dissenting):

In this unusual case my brothers have given the definition in 17 U.S.C. §26 that "the word 'author' shall include an employer in the case of works made for hire" an effect far beyond what I consider the bounds that Congress could have intended. While facts like these may be unlikely to recur, the implications of the opinion are sufficiently alarming to call for an expression of dissent.

Although the course of decision has gone past the point where an argument could be mounted on the failure of

the definition to say that the word "author" shall *not* include the true author in the case of "works made for hire," a position the majority's opinion necessarily entails, it is worth reflecting why the statue is phrased in the curiously back-handed way it is. The rather obvious reason is that the Constitution, Art. I, §8, authorizes only the enactment of legislature securing "authors" the exclusive right to their writings. It would thus be quite doubtful that Congress could grant employers the exclusive right to the writings of employees regardless of the circumstances. In line with that it has been suggested that, in order to be constitutionally viable, §26 must be limited to instances where an assignment of future copyright may fairly be implied. Nimmer, Copyright §6.3 (1968). However that may be, it is surely true that, both in the Constitution and in the Copyright Act, the emphasis is on protecting the "author" and that any principle depriving him of copyright and vesting this in another without his express assent must thus be narrowly confined.

It is often said, as in the majority opinion, that the essential factor in applying the "work for hire" doctrine is "whether the employer possessed the right to direct and to supervise the manner in which the work was being performed." See Nimmer, Copyright §62.2. Where the employer in fact tells the employee pretty much what to do, vesting copyright in the former is wholly consistent with the policy of the Copyright Act since the creativity can be said to be primarily the employer's and the employee has simply carried out his instructions. In fact the decisions go beyond this and also vest copyright in the employer where he has no intention of controlling the detailed activity of the employee but the latter has been employed for the very purpose of producing copyrightable material.

The paradigm instance is the man hired by a music publisher to write songs. To hold that the writer has the copyright would make the contract of employment senseless. A somewhat closer case (on which there is some division of authority, see Nimmer, Copyright §63) concerns the independent contractor commissioner to create a work of art. Even here, while there may not have been an understanding by both parties at the time of contracting that the purchaser should be free to publish or authorize copying of the work, it is not unreasonable to assume in the absence of contrary proof that the parties expected the purchaser to wind up owning the work lock, stock, and copyright and that the artist set his price accordingly. To allow the artist to retain the copyright would thus deprive the purchaser of his bargain and give the artist a windfall. Both these situations, therefore, can be squared with the policy of the Constitution and the Copyright Act on the basis of carrying out what the parties contemplated at the time of contracting, or at least what they probably would have contemplated if they had thought about it.

The majority concedes "it is somewhat of a strain" to assimilate to such cases that of two men who were drafted into the Army or enlisted to avoid the draft and received nothing more than meager military pay. At the time the "employment" relation began, no one had any thought of the production of copyrightable works. And I find no sufficient basis for inferring an intention to vest copyright in the Government from the circumstances under which the plaintiffs translated the model they had already created into a life-size statue. Such an assignment, to a task that would have commanded a high price if performed by a civilian, bears no resemblance to plaintiffs' previous assignment in preparing visual training aids. While the lack of basis for the required inference would be clearer if

plaintiffs were world-famous sculptors, I do not find the difference significant.

In fact the Government's position does not really rest on an inference of probable intent but rather on the supposed unfairness of according copyright to the plaintiffs for a statue allegedly representing the expenditure of $12,367.90 of government funds. Even assuming *arguendo* that such a consideration would suffice to trigger the "work-for-hire" principle, the unfairness is not obvious to me. The Government wanted a statue to display at Fort Dix and got it; there is nothing to suggest it ever thought about publishing copies of the work, with consequent need for owning the copyright. Moreover, the figures are decidedly suspect. They include considerable amounts for the construction of the base of the statue and for moving it to various sites that were considered suitable, and salaries (including an estimate for off-duty hours) of military personnel who would have been paid anyway. On the other hand they do not reflect plaintiffs' claim to have spent some 1,950 hours of valuable leisure time on the statue. If relative financial contributions are the basis for the majority's vesting copyright in the Government, the case, at the very least, is thus inappropriate for summary judgment.

Turning to the two other grounds relied on by the defendants for their motions, I agree with the district court, 297 F. Supp. at 110-11, that the statue was not a publication of the United States Government so that plaintiffs would be deprived of copyright by 17 U.S.C. §8. But I disagree with its ruling, 297 F. Supp. at 111-12, based upon the inadequacy of the copyright notice. Such notice is required only when a person seeks to "secure copyright for his work by publication thereof with the notice of copy-

right required by this title," 17 U.S.C. §10. As opposed to this, 17 U.S.C. §12 provides an alternate procedure for obtaining copyright "of the works of an author, of which copies are not reproduced for sale." Under this section if the article sought to be copyrighted is a work of art, all that needs to be done at the outset to secure copyright is to supply a photograph, which Scherr and Goodman did. The deposit of copies is required only "where the work is later reproduced in copies for sale," and it is the copies that must bear the copyright notice. Hence, so long as Scherr and Goodman did not "publish" the statue or authorize the publication of copies of it, they were under no obligation to affix the notice at all. Such a position is essential if artists are to be spared the dilemma of either defacing the work of art with a plainly visible notice or losing copyright protection. In light of that policy I would also hold that the display of the statue was not a publication, see Nimmer, Copyright §54, although a court presumably would exercise its discretion, 17 U.S.C. §101, not to grant relief against persons whose infringement lay only in photographing the statue for their own pleasure, see 297 F. Supp. at 112, if, as is hardly likely, the plaintiffs should ever seek this.

While I would therefore reverse the judgment for the defendants, it does not follow that one should be entered for the plaintiffs—which indeed, they have not sought. When interviewed by a lieutenant colonel for the Judge Advocate General's office shortly after the unveiling of the statue, Scherr stated that he had no copyright. This might create an estoppel, at least as regards liability for damage as distinguished from an injunction against future infringement.

I would reverse and remand for further development of the facts.

Opinion of United States District Court, Southern District of New York

McGOHEY, *D.J.*

The defendants in this copyright infringement action moved for summary judgment dismissing the complaint on the ground that the subject matter, a statute made at Government expense by soldiers assigned to do so while on active military duty, is a publication of the United States Government and thus is not copyrightable;[1] and that in any event the claimed copyright is invalid for failure of the plaintiffs to affix an adequate notice of copyright to the statute.[2] The latter depicts a charging infantryman in battle dress and is entitled "The Ultimate Weapon."

The action arises from defendant Universal's production and distribution, with the authorization of the Army, of books of matches bearing on the cover a picture of the statute and the legend: "Home of The Ultimate Weapon Fort Dix N. J." The United States (the Government), not originally named as a defendant, intervened. It asks, additionally, that if the copyright is held valid, it be ordered assigned to the Government as an employer under the "works for hire" rule.[3]

The Court finds there is no genuine issue as to any material fact. Summary judgment in favor of the defendants is granted to the extent and for the reasons hereafter stated.

The plaintiffs are two ex-servicemen. Goodman served in the Army from April 1957 to April 1959; Scherr from October 1957 to October 1959. Both men, prior to induc-

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[1] 17 U. S. C. §8.

[2] 17 U. S. C. §19.

[3] 17 U. S. C. §26.

tion, had had education and experience in the fine arts. They were assigned as illustrators to Headquarters Company at Fort Dix, New Jersey, where their duties included the preparation of visual training aids. During his free time, Goodman, using supplies given him by the post hobby shop, began to make a small model of an infantryman which was brought to the attention of the deputy post commander. The latter expressed interest in having constructed a larger statute of an infantryman which would serve as a symbol of Fort Dix. After some preliminary research as to the feasibility of such a project it was agreed that Goodman and Scherr would undertake it. Both men were thereupon relieved of their regular duties as illustrators and they set about to create the proposed statute. With the exception of a few "KP" details and barracks inspections, the plaintiffs devoted all of their regular duty hours, and some of their free time, to the work for a period of nine months.

In the design stage, the plaintiffs used other servicemen, assigned by the Army, as models and photographs of these men taken by Government furnished photographers. The first step in the actual construction of the statute was the making of an "armature" out of scrap metal obtained from various "dumps" located on the base. Sculpt-Metal,[4] which was then applied to the armature,

[4] Sculpt-Metal is a material which can be applied directly to the armature and molded before it hardens, thus saving the time and expense of casting the statue. Goodman had previously worked with this material [Deposition, p. 19], although Scherr had not [Deposition, p. 60]. During the research phase of the project, both men went to Pittsburgh where they were given technical information and instruction regarding the use of Sculpt-Metal. For this trip, plaintiffs were given the use of a Government truck, and while in Pittsburgh they were billeted overnight at a missile base. When they returned to Fort Dix they were reimbursed for whatever expenses they had incurred.

was molded to form the figure of a charging infantryman in battle dress and equipment. The body above the waist is bent forward and on the back, just over the belt, is a field pack. This is boxlike in shape and appears to hang from suspenders which also support a belt. Its front and back panels are of equal size and almost square in dimension. Narrower panels joining the front and back form the other four sides of the box. The completed figure was sprayed with numerous alternate coats of bronze finish and clear lacquer. Most of this work was done in the heavy equipment section of the post engineers' shop at Fort Dix.

The plaintiffs were assisted by two other servicemen, who, in addition to the models, had been assigned as part of their regular duty to work on the project.[5] Furthermore, all heavy equipment and the operators therefor, plus masons, carpenters, blacksmiths and machinists were supplied by the Army. The plaintiffs' only out-of-pocket expenses, estimated to be less than $25 each, were for tools and books. Goodman's car was also used for various errands around the base. The total estimated cost to the Army was more than $12,000.[6] During the course of the project the plaintiffs prepared and submitted progress reports to their superiors. Although the plaintiffs had complete freedom in the design, at one point the officer in charge of the project, noting what he deemed a similarity

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[5] Plaintiffs were also assisted by soldiers from the stockade. Goodman Deposition, p. 41.

[6] During the course of the project, Scherr kept a diary [U. S. A. ex. 1 id.]. The Army's estimated total cost, $12,367.90, was based in part on the entries in this diary. The Army estimate [U. S. A. ex. 8 id.] was conceded by Scherr to be "basically accurate." Scherr Deposition, p. 71.

between Goodman's face and that on the statute, ordered the latter to be changed, which was done. The statue was unveiled on March 20, 1959, and remains on display at Infantryman Park, Fort Dix, a site selected by the Army. The title of the statue was also selected by the Army. The claim of copyright in the name of plaintiffs was registered [7] in June 1959, approximately three months after the unveiling.

The defendants' primary contention is that the statue is a publication of the Government within the meaning of 17 U.S.C. section 8 and is, therefore, not copyrightable. That section provides in pertinent part: "No copyright shall subsist . . . in any publication of the United States Government, or in any reprint, in whole or in part, thereof . . ." The precise scope of the phrase "publication of the United States Government," has long been a source of conflict and concern, as a result of which many definitions and criteria have been suggested for categorizing various works as within or without the prohibition of the section.[8] The issue presented by this motion does not, however, fall within the ambit of this confusion, since in all discussions of the problem there seems to be unanimous, albeit tacit, agreement that "publications of the

[7] 17 U. S. C. §11.

[8] See, e. g. Berger, Copyright in Government Publications, Study No. 33, in Copyright Law Revision, Report of the Register of Copyrights and Studies Nos. 1-34 (1961); Howell, Copyright Law 47 (rev. ed. 1962); Nimmer, Copyright §66 (1964); 12 ASCAP Copyright Law Symposium 96 (1961); 11 ASCAP Copyright Law Symposium 138 (1960); 8 ASCAP Copyright Law Symposium 3 (1957); Comment, 17 Rutgers L. Rev. 579 (1963). *Berger, supra* at 30 notes: "The confusion may be traceable to the dual meaning of the word 'publication'; it may refer to the act of reproducing and distributing copies (printing and distribution by the Government), or it may refer to the work that is being published (a work produced by the Government, i.e., produced for the Government by its employees)."

United States Government" refers to printed works.[9] This conclusion is given added weight by the correspondence of language used to circumscribe the prohibitions found in the Copyright Act and in the Printing Law;[10] and is further buttressed by the fundamental purpose underlying the prohibition which is based on "the necessity of wide public dissemination of the contents of materials produced by and relating to issues and problems of national interest . . . [which] policy is unquestionably a desirable one in a democracy, much of whose success is dependent on a well-informed public."[11] The statue in

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[9] *Berger, supra* note 8 at 35-36 ["In addition to the private use of Government publications for advertising purposes, instances have occurred in which Government publications have been reproduced and sold at high prices without indicating their origin as Government *documents* . . ." (Emphasis added.)]; Comment, 17 Rutgers L. Rev. 579 at 581 (1960) [The problem is to find criteria for determining "what makes a particular *writing* a Government publication." (Emphasis added.)] See also, *Howell, supra* note 8 at 47; *Nimmer, supra* note 8 at 267.

[10] See *Public Affairs Associates, Inc.* v. *Rickover*, 284 F. 2d 262, 268 (D. C. Cir. 1960), vacated and remanded, 369 U. S. 111 (1962). Compare 17 U. S. C. §8 with 44 U. S. C. §58. See *Berger, supra* note 8 at 29-33.

[11] 12 ASCAP Copyright Law Symposium 96 at 105 (1961). Among the other reasons for the prohibition "there is the feeling that if a *literary* product was produced at public expense by a government employee it should be freely available to the public, and the author should not be allowed to impede its free circulation by securing a copyright thereon . . ." Id. (Emphasis added.) Also, there is "the feeling that the public at large is entitled to make whatever use it desires of materials and publications produced at government expense, inasmuch as the Government is supported by the people. Apparently, Congress felt that this interest of the public outweights any need to prevent possible abuses which may occur through distortion, misquotation or excessive pricing of government materials which are privately reproduced." 11 ASCAP Copyright Law Symposium 138 at 141 (1960).

question, it is concluded, is not a "publication of the United States Government" within the meaning of 17 U.S.C. §8.

The defendants next contend that the copyright notice is inadequate, that the claimed copyright is thus invalid and that "The Ultimate Weapon" is, therefore, in the public domain.[12] The statue is twelve feet tall and stands on a pile of rocks about three feet high which, in turn, stands on a base about twelve feet high. Affixed to this base are two plaques, one of which bears the legend: "The Ultimate Weapon—The only indispensable instrument of war—The fighting man." The smaller plaque bears the names of plaintiffs and of the two men who assisted them. Plaintiffs did not affix their notice of copyright to this base, either as part of one of the plaques or separately, because they feared the repercussions, real or imagined, of the Army. Before the unveiling, the statue, without the pack, was taken from the engineers' shop and placed in position on its base. Scherr, unknown to his superiors, then placed a notice of copyright in proper form to the uppermost panel of the pack which he then attached firmly to the back of the soldier. The notice is located close to that back and about twenty-two feet from the ground. It is impossible for anyone standing on the ground to see the notice. In order to do so, one would have to get astride the back of the figure or, in some manner, get positioned above it.[13]

Section 10 of the Copyright Act provides: "Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright

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[12] *Gray* v. *Eskimo Pie Corp.*, 244 F. Supp. 785, 788 (D. Del. 1965).

[13] Goodman Deposition, p. 59-60; Scherr Deposition, p. 110.

required by this title . . ." Section 19 of the Act provides, with respect to *copies* of works of art, that "The notice of copyright required by section 10 . . . shall consist of the letter C enclosed within a circle . . . accompanied by the initials, monogram, mark or symbol of the copyright proprietor; *Provided*, That on some accessible portion of such copies or of the margin, back, permanent base, or pedestal, or of the substance on which such copies shall be mounted, his name shall appear." Defendants do not contend that any of the requisite contents of the notice are missing,[14] but rather that the notice is inadequate because it is improperly placed.

The present Act is silent as to where the notice should appear on works of art.[15] However, the unquestioned purpose of the notice requirement is "to apprise anyone seeking to copy the article, of the existence of the copyright . . ."[16] This purpose was clearly frustrated by plaintiffs who, in their own words, sought to make the

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[14] The notice affixed by plaintiffs contains a letter C enclosed within a circle; the names Stuart Scherr and Steven Goodman; and the date, 1959.

[15] For a thorough discussion of the prior law, see *Coventry Ware, Inc.* v. *Reliance Picture Frame Co.*, 288 F. 2d 193 (2d Cir.), cert. denied, 368 U. S. 818 (1961). See also, *Nimmer supra* note 8 at §87.6 to the effect that where the location of the notice is not prescribed it may be placed anywhere so long as it gives reasonable notice of the claim of copyright.

[16] *Coventry Ware, Inc.* v. *Reliance Picture Frame Co., supra* note 15 at 195, citing *Krussman & Kishel, Inc.* v. *Charel Co.*, 134 F. Supp. 551, 555 (S. D. N. Y. 1955). See also *Ted Arnold Ltd.* v. *Silvercraft, Inc.*, 259 F. Supp. 733 (S. D. N. Y. 1966); *Dan Kasoff, Inc.* v. *Cresco Jewelry Co.*, 204 F. Supp. 694 (S. D. N. Y.), aff'd per curiam, 308 F. 2d 806 (2d Cir. 1962).

notice as inconspicuous as possible,[17] an objective they achieved with singular success. Furthermore, although the Certificate of Registration obtained by plaintiffs is prima facie evidence of the validity of the copyright,[18] the defendants have rebutted this presumption by showing that the notice did not fulfill the statutory purpose—a purpose which plaintiffs had no intention of fulfilling. Since its unveiling, "The Ultimate Weapon" has at all times been, and is today, on view at Infantry Park, a site open to the public. During this time there has never been any restriction, posted or otherwise, on the copying or photographing of the statute.[19] Because the statue was displayed without restriction as to either persons or purpose[20] and without adequate notice, it is concluded that there was a divestive publication under an invalid copyright such as to place "The Ultimate Weapon" in the public domain.[21]

However, even if the copyright notice were valid the plaintiffs would not be entitled to any of the benefits of

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[17] Goodman Deposition, p. 50; Scherr Deposition, p. 109. Additionally, Scherr, when questioned by a JAG officer, stated that he had no copyright.

[18] *Flick-Reedy Corp.* v. *Hydro-Line Mfg. Co.*, 351 F. 2d 546 (7th Cir.); cert. denied, 383 U. S. 958 (1965); *Manes Fabric Co.* v. *Miss Celebrity, Inc.*, 246 F. Supp. 975 (S. D. N. Y. 1965).

[19] Affidavit of James L. R. Ward, a Civilian Special Services Officer who has been employed at Fort Dix continuously since 1955.

[20] *Continental Cas. Co.* v. *Beardsley*, 253 F. 2d 702, 706-07 (2d Cir.), cert. denied, 358 U. S. 816 (1958).

[21] Ball, Copyright and Literary Property §62 (1944); Cary, The Quiet Revolution in Copyright, 35 Geo. Wash. L. Rev. 652, 659-60 (1967). Compare *Carnes* v. *Keefe*, 242 Fed. 745 (D. Mont. 1917) with *Werckmeister* v. *American Lithographic Co.*, 134 Fed. 321 (2d Cir. 1904). Compare also *Howell*, *supra* note 8 at 66 with *Nimmer*, *supra* note 8 at 212-13.

the copyright protection because, as the defendants contend, the statute falls within the "works for hire" rule of 17 U. S. C. §26 and, therefore, any and all copyright interest in the statue belongs to, or inures to the benefit of, the Government.[22]

Various criteria have been suggested for determining whether a given work was made for hire, among these

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[22] Section 26 provides in part: "In the interpretation and construction of this title . . . the word 'author' shall include an employer in the case of works made for hire." The initial question to be decided is whether an employment relationship existed. *Nimmer, supra* note 8 at §62.2 states: "The crucial question in determining an employment relationship is whether the alleged employer has the right to direct and supervise the manner in which the writer performs his work. This is, of course, merely a particular application of the general agency doctrine relating to master and servant." (Footnote omitted.) Under this test, there clearly was an employment relationship. Furthermore, "one may be an employee regardless of whether he is paid on the basis of a conventional periodic salary, on a piece work basis, on a fee or royalty basis, or even if the writing is done as an accommodation with no compensation at all." Id.

See *Sawyer* v. *Crowell Publishing Co.*, 142 F. 2d 497, 499 (2d Cir.) cert. denied, 323 U. S. 735 (1944), affirming 46 F. Supp. 471 (S. D. N. Y. 1942): "We conclude therefore that the district court, was right in holding that any rights which Mr. Sawyer acquired by copyrighting the map [of Alaska prepared by Mr. Sawyer, the Executive Assistant to the Secretary of the Interior, in connection with an assignment in Alaska] must be held in trust for the United States." See also, *United States Ozone Co.* v. *United States Ozone Co.*, 62 F. 2d 881 (7th Cir. 1932); 7 Ops. Att'y Gen. 656 (1956). Compare, *United States* v. *First Trust Co.*, 251 F. 2d 686 (8th Cir. 1958) with *Sherill* v. *Grieves*, 57 Wash. L. Rep. 286, 20 Cpyrt. Off. Bull. 675 (Sup. Ct. D. C. 1929). In *Sawyer* the Government did not intervene and ask for an assignment of the copyright as was done in the instant case. However, in light of our holding of invalidity we do not reach the question of whether the Government is entitled to an assignment of the copyright or whether its remedy is limited to having a judicial declaration that the copyright is held in trust for it. See *Ball, supra* note 21 §219 at 481; 12 ASCAP Copyright Law Symposium 98 n. 8 (1961).

being whether the work was produced within the "scope of employment" and, whether the work was produced on the employer's time and using the employer's facilities.[23] Applying these criteria to the instant facts, it appears that the statue was a work made for hire. The plaintiffs were relieved of their regular duties and assigned to designing and constructing what eventually became "The Ultimate Weapon." During this period they were under military supervision, receiving their pay and their instructions from the Government, and, further, being supplied by the Govment with all the equipment and materials necessary to complete their work.

The plaintiffs' counterargument is three-pronged: they claim that they were relieved of their "official duties" as opposed to their regular duties; that the work was created in a field outside their official classification as illustrators; and finally, that during the course of the nine months they worked on the statue they expended some of their own time and money and used some of their own materials. The first two contentions are not persuasive. The regular duties assigned to the plaintiffs were their official duties. When they were initially assigned to Headquarters Company their Military Occupational Specialty [MOS] was 814.10 which is that of illustrator. Upon being assigned to work on the statue they were not reclassified or given a new MOS, despite the fact that the MOS most closely corresponding to the sculpting they were performing was 815,

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[23] *Nimmer, supra* note 8 §66 at 267; 12 Syracuse L. Rev. 515, 516 (1961). See also *Public Affairs Associates, Inc. v. Rickover*, 369 U. S. 111 (1962). In *Brattleboro Publishing Co. v. Winmill Publishing Corp.*, 369 F. 2d 565 (2d Cir. 1966) the court stated that the works for hire doctrine "is applicable whenever an employee's work is produced at the instance and expense of his employer." Id. at 567.

that of model builder.[24] However, the fact that they were not reclassified does not alter the nature or character of their work for the purposes here being considered. The Army regulations, in fact, provide for the assignment of work outside one's MOS if such an assignment is in the best interests of the Army;[25] and, although reclassification should follow, no rights, penalties or other consequences attend failure of reclassification.[26]

The plaintiffs' final contention, that they expended their own time and money carries little weight. For one thing, the Army spent over $12,000, whereas plaintiffs, by their own estimates, spent less than $50 between them. Furthermore, they make no claim that they requested the Army to furnish them with the supplies they claim to have purchased with their own funds, nor do they suggest that they requested and were denied reimbursement. Goodman, in fact testified that although he expended money in the use of his own car, he never requested a Government

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[24] The work which plaintiffs performed would not fall clearly within the MOS for Model Maker, either. Army Reg. 611-201 at 801 (20 May 1959) defines the duties of a model maker as follows: "Constructs scale models of terrain, bridges, military vehicles and weapons, using materials such as wood, paper mache, plastics and metal."

[25] Army Reg. 611-203 §33(e) (7 March 1955) provided: "When an assignment in the primary advanced MOS is not possible it will be made in the most closely related MOS."

[26] Army Reg. 611-203 §35 (16 Sept. 1957) provided that when assignment was not possible within an individual's primary advanced MOS such "individual will be considered misassigned and will be reported for reassignment . . . Pending reassignment or reclassification, the soldier will be assigned to duty in accordance with the following priorities: (1) MOS in the same entry group (1st two digits of MOS) . . ." The plaintiffs were assigned to work in accordance with this subdivision.

vehicle. Under the plaintiffs' interpretation, any employee could circumvent the "works for hire" rule by expending a comparatively small amount of his own time and/or money on a project arising out of and performed within the scope of his employment. This contention is rejected.

Summary judgment in favor of the defendants may be entered in accordance herewith.

So Ordered.

Dated: New York, N. Y., September 18, 1967.

JOHN F. X. MCGOHEY
U. S. D. J.